

### REMARKS

Claims 1-44 are currently pending in the subject application and are presently under consideration. Amendments to the specification to cure minor informalities are found at pages 2-4. Comments regarding the amendments to the drawings are at page 5. Figures 2-4 have been amended herein to add previously omitted reference numerals. Attached concurrently herewith are Replacement Sheets that include amendments to Figs. 2-4 that address the Examiner's recent objections to the drawings, and a formal version of Fig. 1. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

#### **I. Rejection of Claims 1-4, 9-19, 23-30, 34-37 and 41-44 Under 35 U.S.C. §102(e)**

Claims 1-4, 9-19, 23-30, 34-37 and 41-44 stand rejected under 35 U.S.C. §102(e) as being anticipated by Horstmann *et al.* (US 6,779,022). Withdrawal of this rejection is requested for at least the following reasons. Horstmann *et al.* does not teach or suggest all limitations of the subject claims.

A single prior art reference anticipates a patent claim only if it ***expressly or inherently describes each and every limitation*** set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ***The identical invention must be shown in as complete detail as is contained in the ... claim.*** *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added).

The claimed invention relates to a system and method for an automated electronic messaging system that employs a designated device (*e.g.* mobile phone, portable computer, *etc.*) that receives forwarded messages that were originally directed to a host computer. The invention further allows a user of the designated device to send response messages directly to a sender, while still maintaining origination information (*e.g.* the host computer's address). In particular, independent claims 1, 13, 16, 27 and 34 recite similar limitations, namely *a method for replying to a message from a designated device in an automated messaging system, comprising sending a*

*copy message from a designated device to an address associated with a host computer, said copy message being associated with a reply message.* More particularly, the invention as claimed sends a copy of a reply message (that is responding to an original message that was forwarded from an address associated with a host computer to an address associated with a designated device, where the original message was originally sent from a sender to the address associated with the host computer) from the designated device to an address associated with the host computer in order to facilitate storing all correspondence associated therewith. Horstmann *et al.* is silent regarding such novel aspect of the claimed invention.

Horstmann *et al.* relates to a system that allows for collection of electronic messages from multiple mail sources at a host computer, and provides for forwarding any of these messages to a designated device, such as a wireless device. The cited reference also allows for sending a reply message from the designated device while maintaining originating information (*i.e.* the address associated with the host computer). Horstmann *et al.* discloses providing the host computer with a copy of an *original* message forwarded from the host computer to the designated device. (*See* col. 1, lines 55-62). However, the reference is silent with respect to sending the host computer a copy of the *reply message* sent from the designated device to the address associated with the host computer. The Examiner is reminded that the standard by which anticipation is to be measured is *strict identity* between the cited document and the invention as claimed, not mere equivalence or similarity. *See Richardson* at 9 USPQ2d 1913, 1920.

In view of at least the foregoing distinctions, it is readily apparent that the cited reference does not anticipate or suggest applicant's invention as recited in the subject independent claims (and those that respectively depend there from). This rejection should be withdrawn.

## **II. Rejection of Claims 5-6, 20-21, 31-32 and 38-39 Under 35 U.S.C. §103(a)**

Claims 5-6, 20-21, 31-32 and 38-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Horstmann *et al.* further in view of Pepe *et al.* (WO 97/33421). Applicant's representative respectfully requests that this rejection be withdrawn for at least the following reasons. The cited references, either alone or in combination, fail to teach or suggest all elements of the subject claims.

The subject claims respectively depend from independent claims 1, 16, 27, and 34. As discussed *supra*, Horstmann *et al.* is silent with respect to *a method for replying to a message*

*from a designated device in an automated messaging system, comprising sending a copy message from a designated device to an address associated with a host computer, said copy message being associated with a reply message.* Pepe *et al.* fails to make up for the deficiencies of Horstmann *et al.* Pepe *et al.* relates to a system that can re-direct messages (*i.e.* voice mail, e-mail, *etc.*) from one device (*i.e.* portable computer, desktop computer, PDA, *etc.*) to another device in the same network, wherein the devices share *one correspondence address*. See page 8, lines 2-4. Pepe *et al.* does not allow for replying to a message (the message forwarded from an address associated with a host computer) from an address associated with the designated device to the sender of the original message, while still maintaining origination information (*e.g.* the host computer's address). Consequently, Pepe *et al.* is also silent with respect to sending a copy of the reply message from the designated device to an address associated with the host computer.

Therefore, the cited references do not make obvious applicant's invention as recited in the subject claims, and this rejection should be withdrawn.

### **III. Rejection of Claims 7-8, 22, 33 and 40 Under 35 U.S.C. §103(a)**

Claims 7-8, 22, 33 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Horstmann *et al.* further in view of Lazaridis *et al.* (US 6,219,694). Withdrawal of this rejection is requested for at least the following reasons. Horstmann *et al.* and Lazaridis *et al.*, neither alone nor in combination, disclose or suggest all aspects of the invention as recited in the rejected claims.

The subject claims depend from independent claims 1, 16, 27 and 34. As noted above, Horstmann *et al.* does not disclose or suggest sending a copy of a reply message from a designated device to an address associated with a host computer. Lazaridis *et al.* does not make up for the shortcomings of Horstmann *et al.* Rather, Lazaridis *et al.* relates to a system that re-directs user-selected data items (*e.g.* e-mail) from a host system to a user's mobile data communication device (*i.e.* designated device). The cited reference allows for replying to the data item from the designated device while maintaining the identity of the host computer. However, Lazaridis *et al.* fails to teach or suggest ***sending a copy of the reply message from the designated device to the address associated with the host computer.*** Accordingly, this rejection should be withdrawn.

**Conclusion**


The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [SYMBP144US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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**AMENDMENTS TO THE DRAWINGS**

The attached sheets of drawings include changes to Fig. 2-4. These sheets replace the original sheets including Fig. 1-4. In Fig. 2, previously omitted reference numerals 210, 220 and 230 have been added. In addition, previously omitted reference numerals 310, 320, 330, 340 and 350 have been added to Fig. 3, and previously omitted reference numerals 410, 420 and 430 have been added to Fig. 4.

Attachments: 4 Replacement Sheets